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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/445,614

12/08/1999

Timothy Peter Bonnert

T1481

1165

7590

04/18/2006

Patent Department
Merck & Co Inc
P.O. Box 2000
Rahway, NJ 07065-0907

EXAMINER

BRANNOCK, MICHAEL T

ART UNIT

PAPER NUMBER

1649

DATE MAILED: 04/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/445,614

Applicant(s)

BONNERT, TIMOTHY PETER

Examiner

Michael Brannock

Art Unit

1649

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 February 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 7-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) 1-3 and 7 is/are allowed.
- 6) ☐ Claim(s) 8 and 9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Status of Application: Claims and Amendments

Applicant is notified that any outstanding objection or rejection that is not expressly maintained in this Office action has been withdrawn in view of Applicant's persuasive arguments of February 2, 2006.

Specifically the polypeptide of the instant SEQ ID NO: 2 is 100% identical to the polypeptide disclosed by US Patent Publication 2005/0158827 as SEQ ID NO: 5, which is encoded by a polynucleotide (SEQ ID NO: 4) that has an identical coding region with the instant SEQ ID NO: 1 and what appear to be minor differences in the 5'-noncoding regions, as set forth previously. The polypeptide of SEQ ID NO: 5 and the encoding polynucleotide of SEQ ID NO: 4 of US Patent Publication 2005/0158827 appear to be fully supported by prior application 09/258633 filed 2/26/1999, however there does not appear to be support for the full length SEQ ID NO: 5 polypeptide in either prior application 60/114078 or 60/108322. Additionally, Applicant correctly points out that the Foreign priority claim of the instant application has perfected and acknowledged previously.

New Rejection:

35 U.S.C. §101 states:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 8 and 9 are rejected under 35 USC §101 because the claimed invention is directed to non-statutory subject matter. The specification states that the invention relates to host cells and

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organisms transformed with expression vectors containing vr-1. Thus the cell could be present or intended to be present in a human being, said cell becoming integrated into the human being and therefore being an inseparable part of the human itself. The scope of the claim, therefore, encompasses a human being, which is non-statutory subject matter. As such, the recitation of the limitation "non-human" or "isolated host cell" would be remedial. See 1077 O.G. 24, April 21, 1987.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Brannock, Ph.D., whose telephone number is (571) 272-0869. The examiner can normally be reached on Mondays through Fridays from 10:00 a.m. to 4:00 p.m.

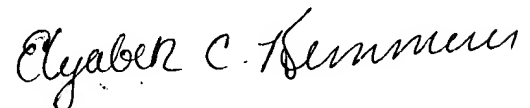
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet Andres, Ph.D., can be reached at (571) 272-0867. Official papers filed by fax should be directed to **571-273-8300**.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

MB



April 16, 2004



ELIZABETH KEMMERER
PRIMARY EXAMINER